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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,760	06/23/2003	Paul A. Ice	B04.12-0072	7344

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EXAMINER	
JAGAN, MIRELLYS	
ART UNIT	**PAPER NUMBER**
2859	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

[redacted]

Offic Action Summary	Application No.	Applicant(s)	
	10/601,760	ICE ET AL.	
	Examiner	Art Unit	
	Mirellys Jagan	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 6/23/03 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 9/23/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to because of the following informalities:

There is lack of antecedent basis in the claim for a separation bend (claim 6 should be dependent on claim 5). Appropriate correction is required.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See ***Miller v. Eagle Mfg. Co.***, 151 U.S. 186 (1894); ***In re Ockert***, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and ***In re Vogel***, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 2 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of U.S. Patent No. 6,609,825 [hereinafter the '825 patent]. This is a double patenting rejection.

4. Claim 4 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of the '825 patent. This is a double patenting rejection.

5. Claims 11-14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7-10, respectively, of the '825 patent. This is a double patenting rejection.

6. Claims 17 and 18 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11 and 12, respectively, of the '825 patent. This is a double patenting rejection.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See ***In re Goodman***, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); ***In re Longi***, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); ***In re Van Ornum***, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); ***In re Vogel***, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, ***In re Thorington***, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '825 patent. Although the conflicting claims are not identical, they are not patentably distinct from each other as follows:

Referring to claim 1 of the application, claim 1 of the '825 patent claims that the angle Θ is between about 35 degrees and about 60 degrees, and claim 1 of the application claims that the angle Θ is between about 35 degrees and about 65 degrees. The phrases "about 60 degrees" and "about 65 degrees" are flexible phrases that include angles near 60 degrees and angles near 65 degrees, respectively. For example, both of the phrases "about 60 degrees" and "about 65 degrees" may include an angle of 63 degrees. Therefore, claim 1 of the application is not patentably distinct from claim 1 of the '825 patent since the phrase "about 60 degrees" in claim 1

of the '825 patent encompasses angles that may also be included in the phrase "about 65 degrees" of claim 1 of the application.

Referring to claim 3 of the application, claim 1 of the '825 patent claims that the angle Θ is between about 35 degrees and about 60 degrees, and claim 3 of the application claims that the angle Θ is between about 35 degrees and about 55 degrees. The phrases "about 60 degrees" and "about 55 degrees" are flexible phrases that include angles near 60 degrees and angles near 55 degrees, respectively. For example, both of the phrases "about 60 degrees" and "about 55 degrees" may include an angle of 57 degrees. Therefore, claim 3 of the application is not patentably distinct from claim 1 of the '825 patent since the phrase "about 60 degrees" in claim 1 of the '825 patent encompasses angles that may also be included in the phrase "about 55 degrees" of claim 3 of the application.

9. Claims 5-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-6, respectively, of the '825 patent. Claims 5-8 of the application, which depend on claim 1, are duplicate claims, respectively, of claims 3-6 of the '825 patent, which depend from claim 1. Therefore, although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons stated above in paragraph 8 with respect to claim 1 of the application.

10. Claims 9 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '825 patent, as stated above in paragraph 8, in view of U.S. Patent 4,821,566 to Johnston et al [hereinafter Johnston].

Claims 9 and 10 claim the limitations of claim 1 the '825 patent except for the probe being mounted on an aircraft engine surface.

Johnston discloses that it is beneficial to place an air temperature-measuring probe at the inlet of an aircraft engine. The probe is attached to a surface at the inlet of the engine in order to measure the temperature of the air entering the engine to determine a required engine thrust (see figure 1, and column 1, lines 14-18 and 31-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify claim 1 of the '825 patent by claiming that the probe is mounted on an aircraft engine surface, since Johnston teaches that it is beneficial to mount a probe at the inlet of an aircraft engine in order to measure the temperature of the air entering the engine and determine a required engine thrust.

11. Claims 15 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of the '825 patent. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 10 of the '825 patent claims that the angle Θ is less than about 80 degrees, and claims 15 and 16 of the application respectively claim that the angle Θ is between about 35 degrees and about 65 degrees, and between about 35 degrees and about 60 degrees. The phrase "less than about 80 degrees" is a flexible phrase that includes angles from 0 degrees to near 80 degrees. Therefore, claims 15 and 16 of the application are not patentably distinct from claim 10 of the '825 patent since the phrase "less than about 80 degrees" in claim 10 of the '825 patent

encompasses angles that are included in the phrases "about 35 degrees and about 65 degrees" and "about 35 degrees and about 60 degrees" of claims 15 and 16 of the application.

12. Claims 19 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of the '825 patent in view of Johnston.

Claims 19 and 20 claim all of the limitations of claim 11 the '825 patent except for the probe being mounted on an aircraft engine surface.

Johnston discloses that it is beneficial to place an air temperature-measuring probe at the inlet of an aircraft engine. The probe is attached to a surface at the inlet of the engine in order to measure the temperature of the air entering the engine to determine a required engine thrust (see figure 1, and column 1, lines 14-18 and 31-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify claim 11 of the '825 patent by claiming that the probe is mounted on an aircraft engine surface, since Johnston teaches that it is beneficial to mount a probe at the inlet of an aircraft engine in order to measure the temperature of the air entering the engine and determine a required engine thrust.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents disclose air temperature measuring probes.

U.S. Patent 6,651,515 to Bernard

U.S. Patent 6,622,556 to May

U.S. Patent 4,403,872 to DeLeo

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 571-272-2247. The examiner can normally be reached on Monday-Friday from 9AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
June 4, 2004

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